

**REMARKS/ARGUMENTS**

Claims 1-22 are pending in this Application.

Claims 1, 3, 8, 9, 11, and 16-22 are currently amended. Applicants submit that support for the claim amendments can be found throughout the specification and the drawings.

Claims 1-22 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-22 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 17-22 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-3, 5, 8, 9-11, 13, 16-18, and 20 stand rejected under 35 U.S.C. § 103(a) being unpatentable over U.S. Patent No. 6,796,489 to Slater et al (hereinafter “Slater”), in view of U.S. Patent No. 6,807,633 to Pavlik (hereinafter “Pavlik”). Claims 4, 12, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater, in view of Pavlik, and in further view of U.S. Patent No. 5,434,917 to Naccache (hereinafter “Naccache”). Claims 6, 7, 14, 15, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater, in view of Pavlik, and in further view of U.S. Patent No. 6,584,459 to Chang et al. (hereinafter “Chang”).

**Objections to the Claims**

Applicants have amended claims 1, 3, 8, 9, and 16 as requested in the Office Action. Thus, Applicants respectfully request reconsideration and withdrawal of the objections to claims 1, 3, 8, 9, and 16.

**Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

Applicants respectfully traverse the rejections to claims 1-22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph as being indefinite.

The Office Action alleges that the term “allowing” in claim 1, “allow” in claim 9, and “allowing” in claim 17 are unclear and indefinite. The Office Action further alleges that it is not clear what the meets and bounds are. Applicants respectfully disagree.

However, in order to expedite prosecution of the Application, Applicants have amended claims 1, 9, and 17. For example, claim 1 recites the feature of “receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature.” Thus, Applicants respectfully request reconsideration and withdrawal of the rejections to claims 1-22 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections Under 35 U.S.C. § 101**

Applicants respectfully traverse the rejections to claims 17-22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 as being directed to non-statutory subject matter for at least a similar rationale as discussed above with respect to the rejections of claims 1, 9, and 17 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections Under 35 U.S. C. § 103(a)**

Applicants respectfully traverse the rejections to claims 1-22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Slater in view of Pavlik, Naccache, and/or Chang. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Slater with the teachings of Pavlik, Naccache, and/or Chang.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants respectfully submit that Slater, Pavlik, Naccache, and Chang, either individually or in combination, fail to teach or suggest at least one of the claim limitations recited in each of claims 1-22.

**Claim 1**

Claim 1 recites a method of associating an electronic signature with an electronic record in a computer system, the method comprising:

receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature;

receiving second user input to define one or more fields stored in the electronic record;

receiving third user input to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record;

receiving fourth user input to define a layout for displaying data in the electronic record on a computer display when an electronic signature for the electronic record is collected;

receiving fifth user input to identify a signatory approver for the electronic record; in response to the occurrence of the event, generating the electronic record and displaying the electronic record to the signatory approver according to the defined layout;

receiving an electronic signature from the signatory approver; and

associating the electronic signature with the electronic record.

Applicants respectfully submit that Slater and Pavlik, either individually or in combination, fail to teach or suggest at least one claim limitation of claim 1.

The Office Action alleges that Slater discloses in Col. 7, lines 5-16 the feature recited in claim 1 of “receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature.” Applicants respectfully disagree.

In Col. 7, lines 5-16, Slater discloses that preparing the electronic document may include “entering data or content into a template.” However, Applicants respectfully submit that simply entering data or content into a template as in Slater does not teach or suggest that user input is received as recited in claim 1 to define an event. Slater merely discloses that the electronic document can be created with or without a template by the user entering data or content into the document. Furthermore, Slater fails to teach or suggest that upon occurrence of the event, an electronic document is created that requires an electronic signature as recited in

claim 1. Thus, the mere act of preparing a document in Slater that requires one or more digital signatures does not teach or suggest that user input is received as recited in claim 1 to define an event that, upon occurrence, generates an electronic record that requires an electronic signature.

Accordingly, Applicants respectfully submit that Slater does not teach or suggest the feature of “receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature” as recited in claim 1.

The Office Action further alleges that Slater discloses in Col. 7, lines 7-13 and Col. 9, lines 50-63 the feature recited in claim 1 of “receiving second user input to define one or more fields stored in the electronic record.” Applicants respectfully disagree.

Again, in Col. 7, lines 7-13 Slater simply discloses that data or content is entered into a template. The data or content disclosed in Slater that is entered into the template is substantially different from the user input that defines one or more fields stored in an electronic record as recited in claim 1.

Additionally, in Col. 9, lines 50-63 Slater simply discloses that the user may input the number of signature blocks that are necessary for the electronic document. However, entering the number of signature blocks in Slater to be included in a document cannot be reasonably interpreted to teach or suggest that user input is received as recited in claim 1 to define one or more fields stored in an electronic record because claim 1 further recites that user input is received to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record. In Slater, the signature block is where the signer digitally signs the electronic document. In contrast, in claim 1, a map maps data from underlying database tables to at least some of the fields defined for the electronic record. The signature block in Slater is substantially different from the one or more fields recited in claim 1.

Thus, Slater does not teach or suggest that user input is received to define one or more fields stored in the electronic record and to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record as recited in claim 1.

The Office Action, however, continues its allegation that Slater discloses in Col. 7, lines 5-14 the feature recited in claim one of “receiving third user input to generate a map that

maps data from underlying database tables to at least some of the fields defined for the electronic record” in the templates “are used to store documents in databases.” Applicants respectfully disagree.

Slater merely suggests that the electronic document may be prepared by entering data or content into a template. Slater does not teach or suggest that the templates in Slater include one or more fields as recited in claim 1, such that a map maps data from underlying database tables to at least some of the fields defined for the electronic record. Furthermore, the act of using a template to store documents in a database as alleged in the Office Action is substantially different from the method recited in claim 1 where a map is generated that maps data from underlying database tables to one or more fields in an electronic record as recited in claim 1.

Accordingly, Applicants respectfully submit that Slater does not teach or suggest the features of “receiving second user input to define one or more fields stored in the electronic record” and “receiving third user input to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record” as recited in claim 1.

The Office Action acknowledges that Slater fails to teach or suggest the feature recited in claim 1 of “receiving fourth user input to define a layout for displaying data in the electronic record on a computer display when an electronic signature for the electronic record is collected.” The Office Action relies upon Pavlik to allegedly cure the deficiencies of Slater in regard to the missing feature recited in claim 1 of “receiving fourth user input to define a layout for displaying data in the electronic record on a computer display when an electronic signature for the electronic record is collected.” However, even assuming *arguendo* that the Pavlik supplies the missing limitation as alleged by the Office Action, Applicants respectfully submit that Pavlik fails to cure the above address deficiencies of Slater in that Slater fails to teach or suggest the features recited in claim 1 of “receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature,” “receiving second user input to define one or more fields stored in the electronic record,” and “receiving third user input to generate a map that maps data from underlying database tables to at least some

of the fields defined for the electronic record.” Thus, the combination of Slater and Pavlik fail to teach or suggest one or more of the claim limitations recited in claim 1.

The Office Action further alleges that the combination of Slater and Pavlik disclose the feature recited in claim one of “in response to the occurrence of the event, generating the electronic record and displaying the electronic record to the signatory approver according to the defined layout.” Applicants respectfully disagree.

The Office Action alleges that Slater discloses generating an electronic record in response to the occurrence of an event in Col. 10, lines 51-55 in that a legal transactions is to be recorded in a county office. However, Slater discloses that content 301 refers to the legal transaction to be recorded in the county office. Thus, the legal transaction in Slater is content which is substantially different from an event or the occurrence of an event as recited in claim 1. Moreover, Slater does not teach or suggest generating an electronic record in response to the occurrence of an event because the electronic document representing the legal transaction is created before recording in the county office. The act of recording in the county office in Slater occurs after the creation of the legal transaction. In contrast, claim 1 recites that the electronic record in generated in response to the occurrence of the event. Thus, Slater fails to teach or suggest an event that, upon occurrence, generates an electronic record and generating the electronic record in response to the occurrence of the event as recited in claim 1.

In light of the above, Applicants respectfully submit that Slater and Pavlik, either individually or in combination, fail to teach or suggest each and every claim limitation recited in claim 1. Thus, Applicants respectfully submit that claim 1 is allowable over the cited references.

### **Claims 2-22**

Applicants respectfully submit that independent claims 9 and 17 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that dependent claims 2-8, 10-16, and 18-22 that depend directly and/or indirectly from the independent claims 1, 9, and 17 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims.

Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

Thus, Applicants respectfully traverse the rejections to claims 4, 12, and 1 in 9 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Slater, in view of Pavlik, and in further view of Naccache. Applicants further respectfully traverse the rejections to claims 6, 7, 14, 15, 21, and 22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Slater, in view of Pavlik, and in further view of Chang.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

/Sean F. Parmenter/  
Sean F. Parmenter  
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 925-472-5000  
Fax: 415-576-0300  
SFP:lls  
61131573 v1